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| 09/931,028      | 08/17/2001  | Toru Hayase          | 0445-0302P-SP       | 2692             |

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BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER

ANDERSON, CATHARINE L

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3761

DATE MAILED: 03/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/931,028

Applicant(s)

HAYASE ET AL.

Examiner

C. Lynne Anderson

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3761

Cnl

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

The amendment filed 26 December 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The ratio of the width of the portions of the diaper containing the elastic members in a stretched state to the width of the diaper being between 40% and 95%.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The ratio of the width of the portions of the diaper containing the elastic members in a stretched state to the width of the diaper being between 40% and 95% is not described in the specification. The ratio of the width of the portion of the diaper containing the elastic members to the width of the diaper is disclosed on page 8, lines 21-24, but the elastic members are not disclosed as being in a stretched state.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "an outer sheet" in line 5. It is unclear whether this outer cover is the same outer sheet as disclosed in claim 2, from which claim 3 depends, or a second outer sheet. In light of the instant specification, the examiner will examine the claim as though the outer sheet of claim 3 is the same outer sheet as disclosed in claim 2.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Ashton et al. (WO 99/60969 A1).

Ashton discloses a shorts-type disposable diaper 20, as shown in figure 1, comprising a liquid permeable topsheet 24, a liquid impermeable anti-leakage sheet 68,

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and a liquid retentive absorbent core 25. A body surrounding portion 38 is located between a waist opening 36 and leg openings 34, as shown in figure 1. The body surrounding portion 39 contains side portions 46, 48, and a plurality of elastic members 70 which extend in a circumferential width direction of the diaper 20, as shown in figure 3. The elastic members 70 are disposed in the side portions 46, 48 of the diaper 20, but no elastic member are disposed in at least a center portion 54 of the body surrounding portion 38 where the absorbent core 25 exists, as shown in figure 3. The ratio of the width of the absorbent core 25 to a width of the diaper 20 where the elastic members 70 are disposed is about 44%, as measured from figure 3. The ratio of width of the portions of the diaper 20 that contain the elastic members 70 to the width of the diaper 20 is also about 44%, as measured from figure 3. When the elastic members 70 are in a stretched state, the width of the elastic members 70 to the width of the diaper 20 will inherently still fall within the range of 40% to 95%, since as the elastic members 70 are stretched, the width of the elastic members 70 and the width of the diaper 20 will increase equally.

With respect to claim 2, the elastic members 70 are disposed between an outer sheet 23 and the anti-leakage sheet 68, as shown in figure 5.

With respect to claim 3, the diaper 20 comprises an absorbent body 41 containing the topsheet 24, the anti-leakage sheet 68, the absorbent core 25, and an exterior member containing the outer cover 23, as shown in figure 5. The exterior member is disposed on the side of the absorbent body 41 having the anti-leakage sheet

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68, as shown in figure 5, and the absorbent body 41 and exterior member are fixed together by partial bonding, as described on page 20, lines 23-27.

With respect to claim 4, an elastic member 6 extends in a circumferential width direction of the diaper 20 and is fixedly disposed in the waist opening portion 37, as shown in figure 1. The extensibility of the elastic member 6 is greater than that of the elastic members 70, as disclosed on page 37, line 33, to page 38, line 3. The 30% elongation stress of the waist opening portion 37 is therefore greater than the 30% elongation stress of the body-surrounding portion 39.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ashton et al. (WO 99/60969 A1) as applied to claim 1 above, in view of Iskra (5,021,050).

Ashton discloses all aspects of the claimed invention but remains silent as to the Taber stiffness of the absorbent core.

Iskra discloses a disposable diaper 10, as shown in figure 1, comprising an absorbent core 16, as shown in figure 3. The absorbent core 16 has a Taber stiffness of less than about 7 g/cm, as disclosed in column 3, lines 31-40. The low Taber stiffness of the absorbent core 16 allows the absorbent core 16 to be flexible enough to bend to form the shape of the diaper 10, as shown in figure 1.

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It would therefore be obvious to one of ordinary skill in the art at the time of invention to construct the absorbent core of Ashton with a Taber stiffness of less than about 7 g/cm, as taught by Iskra, to give the absorbent core a suitable flexibility.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Lynne Anderson whose telephone number is (703) 306-5716. The examiner can normally be reached on Monday through Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (703) 308-1957. The fax phone numbers for

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the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 306-4520 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

*CLA*  
cla  
February 25, 2003

  
**WEILUN LO**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3700**